

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated May 21, 2004, in which:

- claims 7, 17, and 22 are rejected under 35 U.S.C. § 101, statutory double patenting, based upon Shah-Nazaroff, *et al.* US Patent No. 6,157,377);
- claims 1-6, 8, 14-16, 18-21, 23, and 25-26 are rejected under the judicially created doctrine of obvious-type double patenting, based upon Shah-Nazaroff, *et al.* US Patent No. 6,157,377);
- claims 1, 2, 8, 11-15, 18, 21, 23, 25, and 26 are rejected under 35 U.S.C. § 102(e) on Carrubba *et al.* (hereafter, 'Carrubba,' US Patent No. 5,629,866);
- claims 3-6, 9, 10, 16, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrubba in combination with Official Notice;
- claims 7, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrubba in combination with Maeng. (US Patent No. 6,476,873 B1);
- and claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Carrubba in combination with both Maeng, and Hjelsvold *et al.* (hereinafter 'Hjelsvold;' US Publication No. 2003/0145333 A1).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 3 month(s), including the appropriate fee, is filed herewith.

Claims 1-6, 8-16, 18-21, and 23-26 are now pending the above referenced patent application. No claims have been amended, cancelled, or added. Claims 7, 17, and 22 have been cancelled to address minor matters of form, and, therefore, do not result in prosecution history estoppel and do not alter the scope of the claims as originally filed. No claims have been amended, or added. No new matter has been entered.

1. 35 U.S.C. § 101

1.1. *Statutory Double Patenting: Claims 7, 17, and 22*

The PTO has rejected claims 7, 17, and 22 under 35 U.S.C. § 101 as a double patenting of the “same invention.” The PTO asserts that claims 7, 17, and 22 claim the same invention as that of claims 1, 11, and 16, respectively, of issued U.S. patent no. 6,157,377.

It is well-established that in order to establish a *prima facie* case of statutory double patenting under § 101 of the patent statute, the PTO must provide that there is no conceivable product or process that would fall literally within the scope of one patent application’s claims without falling within the other patent application’s claims. To illustrate how narrow the doctrine of statutory double patenting is, in *Deters*, a claim that included an element of “at least one” surface was held not identical to a claim in which the element was for “a plurality” of surfaces because the former but not the latter literally read on a one-surface structure. *In re Deters*, 515 F.2d 1152, 185 U.S.P.Q. 644 (CCPA 1975). Therefore, if even a single conceivable embodiment would not literally fall within both sets of claims, then the PTO has not succeeded in establishing a *prima facie* case.

Applicants have cancelled the rejected claims to address the PTO’s concerns. It is respectfully asserted that these cancellations are merely directed to matters of form, and, therefore, do not result in prosecution history estoppel and do not alter the scope of the claims. It is respectfully requested that the foregoing claim rejections be withdrawn.

1.2. Non-Statutory Double Patenting: Claims 1-6, 8, 14-16, 18-21, 23, and 25-**26**

The PTO has rejected claims 1-6, 8, 14-16, 18-21, 23, and 25-26 under the judicially created doctrine of obvious-type (non-statutory) double patenting. The PTO asserts that claims 1-6, 8, 14-16, 18-21, 23, and 25-26 claim the same invention as that of claims 1-6, 11, 12, 14, 16, and 17 of issued U.S. patent no. 6,157,377.

M.P.E.P. § 804.02(II) sets forth the standard for avoiding a non-statutory double patenting rejection:

804.02 Avoiding a Double Patenting Rejection**II. NONSTATUTORY**

37 CFR 1.130 Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl*, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and *In re Griswold*, 365 F.2d 834, 150 USPQ 804 (CCPA 1966). The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). To establish a prima facie case of obviousness, three basic criteria must be met.

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The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

Applicants have filed a terminal disclaimer as part of this response. Applicants hereby disclaim the terminal part of the statutory term of any patent granted on the current application which would extend beyond the expiration date of the full statutory term of U.S. patent 6,157,377, as described in detail the attached terminal disclaimer document. It is respectfully requested that the foregoing claim rejections be withdrawn.

2. 35 U.S.C. § 102

2.1. Carrubba: Claims 1, 2, 8, 11-15, 18, 21, 23, 25, and 26

The PTO has rejected claims 1, 2, 8, 11-15, 18, 21, 23, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Carrubba. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 1. Claim 1 recites:

- 1 1. (Original) A method comprising:
- 2 receiving a selection to buy an upgraded media feature for a programming
- 3 transmission;
- 4 automatically coordinating purchase of the upgraded media feature for the
- 5 programming transmission; and
- 6 automatically coordinating provision of the upgraded media feature for the
- 7 programming transmission.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Carrubba does not show, teach, use, or describe an

automatically coordinating purchase of the upgraded media feature. Carrubba instead merely alludes to the upgraded or "complementary" features costing money, not that the purchase may be automatically coordinated nor how to do it. See, Carrubba column 4, lines 35-42. Applicants respectfully contend that Carrubba fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

Claims 2, 8, 11-15, 18, 21, 23, 25, and 26 either depend from claim 1, or include a substantially similar and patentably distinct limitation as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

3. 35 U.S.C. § 103(a)

3.1. *Carrubba and Official Notice: Claims 3-6, 9, 10, 16, 19, and 20*

3.1.1. Official Notice: Request for Documentation

The PTO's Official Notice of the use of "provid[ing] billing information about the client to programming sources, receiving a bill for the portion of the services performed and/or receiving a bill based on the upgraded feature for the typical advantage of appropriately charging clients for services provided to them from the corresponding transmission sources" is respectfully traversed. While Applicants respectfully traverse the Official Notice in its entirety, Applicants specifically traverse that knowledge of "receiving a bill based on the upgraded features" is well known in the art. Applicants request that the PTO furnish documentary evidence showing prior art that alone or in combination meets all the elements of the Applicants' claimed subject matter and showing why one skilled in that art would be motivated to combine the subject matter of the Official Notice with the subject matter of the Carrubba, which as described above does not contain all the elements and limitations of the claims.

3.1.2. Remarks

The PTO has also rejected claims 3-6, 9, 10, 16, 19, and 20 under 35 U.S.C. § 103(a) based upon Carrubba in combination with Official Notice. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Applicant begins with claim 3. Claim 3 recites:

1 3. (Original) The method of claim 1 wherein the automatically coordinating the purchase of the
2 upgraded media feature comprises:
3 billing a client for services performed by a server system; and
4 providing billing information about the client to at least one of a plurality of
5 programming transmission sources that provided the programming transmission.

Claim 3 ultimately depends from the independent claim 1. Claim 1 recites:

1 1. (Original) A method comprising:
2 receiving a selection to buy an upgraded media feature for a programming transmission;
3 automatically coordinating purchase of the upgraded media feature for the programming
4 transmission; and
5 automatically coordinating provision of the upgraded media feature for the programming
6 transmission.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Carrubba nor subject of the Official Notice, either alone or in combination, suggests or describes automatically coordinating purchase of the upgraded media feature. The PTO asserts that the smart card of Carrubba teaches this limitation. See, Carrubba column 4, lines 35-42. However, it is respectfully asserted that Carrubba does not teach this limitation. See discussion above. Carrubba instead merely alludes to the upgraded or "complementary" features costing money, not that the purchase may be automatically

coordinated nor how to do it. Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 4-6, 9, 10, 16, 19, and 20 either depend from and include the limitations of claim 3, or include a substantially similar and patentably distinct limitation as claim 3. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 3. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

3.2. Carrubba and Maeng: Claims 7 and 17

The PTO has also rejected claims 7 and 17 under 35 U.S.C. § 103(a) on Carrubba in combination with Maeng. The rejection of these claims is also traversed.

While Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for a variety of reasons, Applicants respectfully assert that the cancellation of the claims, for other reasons, renders the rejection moot. Therefore, Applicants will not address the merits of the rejection.

It is respectfully asserted that these cancellations are merely directed to matters of form unassociated with the § 103 rejection, and, therefore, do not result in prosecution history estoppel and do not alter the scope of the claims. It is respectfully requested that the foregoing claim rejections be withdrawn

3.3. Carrubba, Maeng, and Hjelsvold: Claim 22

The PTO has also rejected claim 22 under 35 U.S.C. § 103(a) on Carrubba in combination with Maeng and Hjelsvold. The rejection of this claim is also traversed.

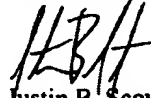
While Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for a variety of reasons, Applicants respectfully assert that the cancellation of the claims, for other reasons, renders the rejection moot. Therefore, Applicants will not address the merits of the rejection.

It is respectfully asserted that these cancellations are merely directed to matters of form unassociated with the § 103 rejection, and, therefore, do not result in prosecution history estoppel and do not alter the scope of the claims. It is respectfully requested that the foregoing claim rejections be withdrawn

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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Dated:

Sub Nov 21, 2004

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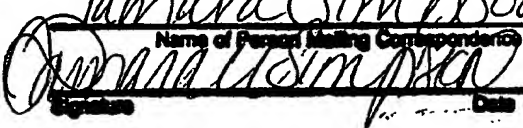
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